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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Author Services, Inc.

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Serial No. 76/227,464

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Thomas M. Small and J. Alison Grabell of Birch, Stewart, Kolasch & Birch, LLP for Author Services, Inc.

Gwen P. Stokols, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

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Before Hohein, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Author Services, Inc. has filed an application to register the designation "BATTLEFIELD EARTH" as a trademark for

"pre-recorded audio tapes and video tapes and pre-recorded compact discs featuring a series of science fiction books."[1]

Registration has been finally refused under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that as used on the specimens, the designation "BATTLEFIELD EARTH" does not function as a trademark for applicant's goods. Instead, according to the Examining Attorney, such designation is used on the specimens of use as a title of a single creative work.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

By way of background, applicant asserts in its initial brief that it "has used and registered its BATTLEFIELD EARTH mark in numerous ways that lead to the inescapable conclusion that the mark is a trademark for a variety of goods and services, and not merely the title of a single creative work." However, with respect to the instant application, applicant admits that "the connection between this mark, these goods, and the book and motion picture entitled 'Battlefield Earth' is not denied." Applicant also acknowledges that it "is engaged in an extensive merchandising campaign involving the sale and

[1] Ser. No. 76/227,464, filed on March 20, 2001, which alleges a date of first use anywhere and in commerce of October 18, 1991.

licensing of merchandise that arises out of and is based upon various aspects of the book and motion picture." Applicant nonetheless maintains that "the purchasing public readily recognizes such merchandising marks and associates them with a single source," as is the case herein.

In particular, unlike In re Cooper, 254 F.2d 611, 117 USPQ 396, 398 (CCPA 1958), and other cases cited by the Examining Attorney which hold that a designation used as the title of and/or a character name in a book is not registrable as a trademark for books, applicant stresses that it "is seeking registration ... for pre-recorded audio tapes and video tapes and pre-recorded compact discs, *not* books" (italics in original). Applicant urges that, in the present case (underlining in original):

> Each of the goods is a separate and different product. Further, the products containing "creative works" contain separate and different works. For example, the compact disc contains the musical soundtrack from the motion picture "Battlefield Earth"; the packaged audio edition of the book is an abridged version narrated by Roddy McDowell; a special hardcover edition of the book commemorates the twentieth anniversary of the book's publication, in addition to the mass-market paperback version; tee shirts contain imagery created by various artists ...; and on-line games that have been available over the Internet are separate creations. Each of these works is a separately copyrightable work. BATTLEFIELD

> EARTH is not merely the title. It is, beyond legitimate argument, a registered trademark owned by Applicant for a variety of goods and services, and [it is] also used as a trademark for the goods identified in this application.

As support for its contentions, applicant relies on the declaration which it submitted from its Secretary, Ryland Hawkins, as well as its ownership of two subsisting registrations for the mark "BATTLEFIELD EARTH." Mr. Hawkins states in his declaration that, among other things, he has been continuously employed by applicant for more than 15 years; that, "[i]n addition to the numerous goods shown in the specimens originally filed in this application, ...[consisting of] a Books On Tape (unabridged) audio tape read by Michael Russotto and a Bridge Publications, Inc. tape cassette (abridged) read by Roddy McDowell, ... applicant and its licensees have used the BATTLEFIELD EARTH mark on" the following items:

> "a. compact discs containing the musical soundtrack from the motion picture entitled 'Battlefield Earth' ...";
>
> "b. DVD and video of the motion picture entitled 'Battlefield Earth' ...";
>
> "c. a five-volume literary work constituting the Japanese version of the original book entitled 'Battlefield Earth' ...";
>
> "d. numerous different paperback editions of the book entitled 'Battlefield Earth' using the logo or sold under the wordmark [sic] ...";

> "e. several different leather-bound editions of the book entitled 'Battlefield Earth' ..."; and
>
> "f. an edition of 'Starlog Magazine'";

that "[t]he above-identified exhibits show uses of the 'Logo' form of the mark and also use the 'wordmark' [sic] form of the mark"; and that "[a]ll of these uses pre-date the filing" of applicant's application. Applicant also observes that:

> [A]s shown in Applicant's existing registration[s], BATTLEFIELD EARTH already is registered for: Computer Game Cartridges, Programs and Screen Saver Programs ...; Trading Cards, Books and Calendars ...; T-shirts and Caps ...; and Computer On-line Services ... (Registration No. 2,376,207); and Toy and Toy Action Figures ...; and entertainment services ... (Registration No. 2,532,219) [sic].

The Examining Attorney, on the other hand, correctly points out in her brief that, under Sections 1, 2 and 45 of the Trademark Act, it is well settled that "a mark may not be registered if it is merely the title of a single creative work," citing In re Cooper, supra, and In re Caserta, 46 USPQ2d 1088, 1091 (TTAB 1998). Our principal reviewing court, we note, recently reaffirmed such principle in Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1379-80 (Fed. Cir. 2002). The reason why a designation may not be registered if it is used merely the title of a single creative work, such as a book, is that, as stated for instance in

Caserta, supra, "titles of books are considered to be nothing more than the name by which the book may be identified in much the same way that other items of merchandise are identified." As explained in *Cooper*, supra at 399-400 (italics in original), in which the term "TEENY-BIG" was refused registration as a trademark for books because it was used solely as the title of a single book:

> The purchaser of a book [requested by its title] is not asking for a "kind" or "make" of book. He is pointing out which one out of millions of distinct titles he wants, designating the book by its name. ....
>
> ....
>
> .... But however arbitrary, novel or non-descriptive *of contents* the name of a book--its title--may be, it nevertheless *describes* the book. ....
>
> Appellant appears to argue that there is an inconsistency in registering as a trademark the name for a series of books and in not registering the title of a single book. We see no inconsistency. The name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any one book and each book has its individual name or title. A series name is comparable to the title of a periodical publication such as a magazine or newspaper. While it may be indicative either specifically or by association in the public mind, of the general nature of the contents of the publication, it is not the name or title of anything contained in it. A book title, on the other hand[,] especially one

> which is coined or arbitrary, identifies a specific literary work, of whatever kind it may be, and is not associated in the public mind with the publisher, printer or bookseller ....
>
> As TEENY-BIG is no more than the name of a book, its only name, it is not a trademark under the statute .... Hence, TEENY-BIG was properly refused registration. ....
>
> In saying that TEENY-BIG is the name of a book, we note that in this context the term "book" has a dual aspect. First, it is an article of manufacture which can be sold in the marketplace. As such, it is not unlike blankbooks or pads of paper. Secondly, it contains, by virtue of the printing on the paper, an intellectual content which is incorporeal--the story. The title of the "book" does not really pertain to the first aspect at all but identifies, names or describes the incorporeal literary content, which is subject to the laws pertaining to literary property. ....

The same is likewise true with respect to the titles of plays and movies, see In re Posthuma, 45 USPQ2d 2011, 2013-14 (TTAB 1998) [the name "PHANTASM," used solely as the title of a play, is not registrable as a service mark for "entertainment services in the nature of a live theater production"], and would also be true, by analogy to books, with respect to the titles of pre-recorded audio tapes, video tapes and compact discs which, for example, have science fiction books as their subject matter or contents. As stated in *Cooper*, supra at 401: "Suffice it to say that the same principles of law apply to the registration of

trademarks for all kinds of goods." Moreover, as pointed out in *Posthuma*, id. at 2014:

> To allow registration of play titles and not book titles would lead to the anomalous result of registering such titles as "Ragtime" and "]Having Our Say" for a single theatrical production, but not allowing registration when these same titles are used as book titles. Titles of plays and book titles (or, for that matter, movie titles) are likely perceived in the same manner by the public, so we see no reason why they should be treated differently by the [U.S. Patent & Trademark] Office.

The determination of whether a designation nevertheless functions as a mark is based upon consideration of its manner of use as shown by the specimens. Like the appellant in *Cooper*, the gist of applicant's argument herein is that because it has used the designation "BATTLEFIELD EARTH" in connection with the goods for which it presently seeks registration and has also registered such designation for a variety of other goods and services which assertedly are related thereto, it is necessarily the case that the purchasing public would perceive applicant's manner of use of "BATTLEFIELD EARTH" as a trademark for its pre-recorded audio tapes, video tapes, and compact discs which feature a series of science fiction books. However, as noted in *Cooper*, it similarly is the case herein that (italics in original):

> Appellant appears to assume that [its applied-for mark] TEENY-BIG has been used *as*

> *a trademark* for books in asking that it be registered, but that is what we have to decide. Nothing we say should be taken as implying that no trademark for books can be registered; but before there can be registration there must be a trademark and a trademark exists only where there has been trademark use.

Id. at 398. Therefore, as generally set forth in In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 215-16 (CCPA 1976) (italics

in original; citations and footnote omitted):

> The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify. ....
>
> An important function of specimens in a trademark application is ... to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used *as a trademark* with respect to the goods named in the application. ....

Here, as previously indicated, applicant's goods are identified as "pre-recorded audio tapes and video tapes and pre-recorded compact discs featuring a series of science fiction books." As pointed out by the Examining Attorney in her brief, applicant's goods consequently include "books on tape or compact disc." "A book on tape or CD," the Examining Attorney further observes, "is a recorded version of a book read out loud." Thus, unless the specimens submitted by applicant demonstrate use of the designation "BATTLEFIELD EARTH" as the name or title of a series of pre-recorded science fiction books on audio tapes, video tapes and compact discs, rather than merely as basically the title of a single creative work, such designation is not registrable as a trademark for applicant's goods. See,

e.g., In re Scholastic Inc., 23 USPQ2d 1774, 1777-78 (TTAB 1992).

We agree with the Examining Attorney that none of the specimens submitted by applicant shows use of the designation "BATTLEFIELD EARTH" as anything other than the title of, in essence, a single creative work. For example, as illustrated by the specimens originally filed by applicant, the "BOOKS ON TAPE" audio tapes consist of a package of "30 CASSETTES" while the single tape version is packaged in a printed sleeve or box. Most prominently displayed on both of such specimens is the title of the pre-recorded book, "BATTLEFIELD EARTH," and the name of the author of such work, "L. RON HUBBARD." In each instance, and in significantly smaller size type, there respectively appear above and below the title the preface "The International Bestseller" and the legend "Now a Major Motion Picture Starring: JOHN TRAVOLTA, BARRY PEPPER and FOREST WHITAKER." The only apparent difference between such specimens is that one version is "READ BY MICHAEL RUSSOTTO" while the other is "READ BY RODDY MCDOWELL."

In a similar manner, the compact disc specimens submitted with the Hawkins declaration display, in large size lettering, the title "BATTLEFIELD EARTH," which is preceded, in much smaller size type, by the wording "ORIGINAL MOTION PICTURE SOUNDTRACK." Such specimens also prominently feature the legend

"MUSIC COMPOSED BY ELIA CMIRAL." Along the same lines, both the DVD and video tape specimens which accompany the Hawkins declaration prominently feature the title "BATTLEFIELD EARTH," which is preceded by the name "JOHN TRAVOLTA" which appears immediately above such title but in noticeably smaller size type. Both of such specimens also bear the term "SPECIAL EDITION" and each appears to be derived from or based upon the book by L. Ron Hubbard entitled "BATTLEFIELD EARTH." Finally, the printed book specimens attached to the Hawkins declaration display the titles of the books as either "BATTLEFIELD EARTH" or a variant thereof, "Battlefield Earth," together with the name of the author of such books, "L. Ron Hubbard," while the accompanying edition of "Starlog Magazine" appears to contain a cover article devoted to the motion picture made from the book and entitled "BATTLEFIELD EARTH."

Consequently, as the Examining Attorney accurately observes in her brief, not only is it the case that "the mark, as used in connection with the books on tape and CD, is a title," but "the evidence demonstrates variations of the same book, not a series of books" as indicated in the identification of goods set forth in the application. All of the goods for which applicant seeks registration of the designation "BATTLEFIELD EARTH" plainly appear to be based on or derived from the same creative work, namely, the science fiction book by

L. Ron Hubbard which is entitled "BATTLEFIELD EARTH." Nothing in any of the specimens is indicative of a series of pre-recorded audio tapes, video tapes and compact discs, such as a reference to a multi-volume set (e.g., "Volume 1," "First in a Series," etc.). Furthermore, the fact that the book entitled "BATTLEFIELD EARTH" has been recorded by two different readers (Michael Russotto and Roddy McDowell) and has been made into a motion picture, with a separately available soundtrack recording, all of which bear the title "BATTLEFIELD EARTH," does not show that a series of audio tapes, video tapes and compact discs featuring science fiction books exists, much less that the designation "BATTLEFIELD EARTH" is a trademark for such goods rather than simply the title of what is essentially a single creative work as recorded therein.[2] See, e.g., In re Posthuma, supra at 2014 [while recognizing that "the nature of live theater dictates that changes will occur from time to time in a stage production," "the essential story of the play remains, by and large, intact" and thus, "[w]hatever the changes made to this live theater production, it still remains a single work"

[2] As the Examining Attorney also properly points out in her brief, "the only way to overcome such a refusal is to provide evidence that the mark is used in connection with a series." The refusal herein, she further notes, is thus unlike a refusal on the ground that a proposed mark is used on the goods in a decorative or ornamental fashion, which may be overcome by the presentation of evidence showing that the proposed mark would be recognized as a mark in light of its use as a mark in connection with other goods and/or services. Compare TMEP Section 1202.08 with TMEP Section 1202.03.

and the "often subtle changes do not transform the show into a 'series' of shows, thereby turning the unregistrable title into a registrable service mark"].

Accordingly, in the absence of specimens showing that the designation "BATTLEFIELD EARTH" functions as a mark for applicant's "pre-recorded audio tapes and video tapes and pre-recorded compact discs featuring a series of science fiction books" and is not simply the title of essentially a single creative work, it is not registrable as a trademark for such goods.

Decision: The refusal to register is affirmed.